

AMENDMENTS TO CLAIMS

Claim 1 (presently amended): A structural reinforcing member for reinforcing a hollow structural member comprising;

a plastic reinforcing member having on the surface thereof an expandable material that is substantially dry to the touch prior to activation;

wherein the surface of the reinforcing member is provided with at least one extension;

wherein the at least one extension is integrally molded with the carrier;

wherein the at least one extension, upon insertion of the reinforcing member within the hollow structural member, both opposes and approaches an internal surface of the hollow structural member; and adapted for opposing and which approaching an internal surface of the hollow structural member when the reinforcing member is placed within the hollow structural member

wherein the expandable material is located against the at least one of ~~the one~~ extensions such that the at least one extensions locally guides the expansion of the expandable material toward the internal surface of the hollow structural member.

Claim 2 (original): A structural reinforcing member according to Claim 1 in which the exterior profile shape of the reinforcing member conforms substantially to the cross section of the hollow structural member.

Claim 3 (presently amended): A structural reinforcing member according to Claim 2 in which the size of the reinforcing member including the expandable material is such that there is a clearance not more than 1 cm between the outer surfaces ~~extremity~~ of the reinforcing member and the internal surface ~~opposing interior walls~~ of the hollow structural member.

Claim 4 (presently amended): A structural reinforcing member according to Claim 1 in which the reinforcing member is an injection molded plastic and has an internal structure that is selected from cellular, honeycomb or ribbed ~~internal structure.~~

Claim 5 (original): A structural reinforcing member according to Claim 1 in which the extensions are selected from ribs, raised embossments or a part of a stamped area.

Claim 6 (original): A structural reinforcing member according to Claim 1 which the extensions are of increased thickness relative to adjoining sections of the reinforcing member.

Claim 7 (original): A structural reinforcing member according to Claim 1 provided with small lugs, which enable the structural reinforcing member to stand away from the interior walls of the hollow structural member.

Claim 8 (original): A structural reinforcing material according to Claim 3 in which the clearance is 2 to 10 mm.

Claim 9 (original): A structural reinforcing member according to Claim 1 in which the reinforcing member is made from filled polyamide.

Claim 10 (original): A structural reinforcing member according to Claim 9 in which the filler is glass fibre.

Claim 11 (original): A structural reinforcing member according to Claim 9 in which the filler is carbon fibre.

Claim 12 (original): A structural reinforcing member according to Claim 1 in which the reinforcing member is made from a thermosetting resin.

Claim 13 (original): A structural reinforcing member according to Claim 1 in which the expandable material can be activated to both expand and to act as an adhesive when heated.

Claim 14 (original): A structural reinforcing member according to Claim 13 in which the expandable material can be activated at a temperature of a curing step in an electrocoat process.

Claim 15 (original): A structural reinforcing member according to Claim 1 in which the expandable material is an expandable adhesive material.

Claim 16 (original): A structural reinforcing member according to Claim 15 in which the expandable adhesive material is a foamable epoxy-base resin.

Claim 17 (original): A structural reinforcing member according to Claim 1 in which the expandable material is applied to at least a portion of the surfaces of the rigid reinforcing member that will be adjacent to two non-parallel surfaces of the interior surface of the hollow structural member.

Claim 18 (original): A structural reinforcing member according to Claim 17 in which the expandable material is applied over part of each of the top and bottom and the sides of the reinforcing member.

Claim 19 (original): A structural reinforcing according to Claim 1 in which the extensions comprise at least two ribs and the expandable material is provided between the ribs.

Claim 20 (original): A structural reinforcing member according to Claim 19 in which a series of pairs of ribs are intermittently provided along one or more of the surfaces of the reinforcing member.

Claim 21 (original): A structural reinforcing member for reinforcing a hollow structural member comprising:

a pair of opposing rib mouldings extending the length of said structural reinforcing member;

unfoamed expansive adhesive material contained between said opposing ribs and said structural reinforcing member;

wherein said unfoamed expansive adhesive material can be activated to both expand and to act as an adhesive when heated;

wherein said unfoamed expansive adhesive material is dry and not tacky to the touch prior to activation of said material;

wherein said structural reinforcing member further comprises at least one lug attached to said structural reinforcing member and locating said member within said hollow structural member when said structural reinforcing member is placed within said hollow structural member and said opposing rib mouldings approach an internal surface of the hollow structural member prior to activation of said material; and

wherein said opposing rib mouldings are bonded to said internal surface of said hollow structural member after activation of said material.

Claim 22 (original): The structural reinforcing member according to Claim 21 in which the exterior profile shape of said reinforcing member conforms substantially to the interior cross section of said hollow structural member.

Claim 23 (original): The structural reinforcing member according to Claim 21 in which the size of said reinforcing member including the expandable material is such that there is a clearance of not more than 1 cm between said opposing rib mouldings of said reinforcing member and said interior wall of said hollow structural member.

Claim 24 (original): The structural reinforcing member according to Claim 21 in which the expandable material can be activated at a temperature of a curing step in an electrocoat process.

Claim 25 (original): The structural reinforcing material according to Claim 23 in which the clearance is 2 to 10 mm.

Claim 26 (original): The structural reinforcing member according to Claim 21 in which the reinforcing member is an injection molded plastic and has a cellular, honeycomb or ribbed internal structure.

Claim 27 (presently amended): The structural reinforcing member according to Claim 21 in which the reinforcing member is made from a filled polyamide that includes a fibrous filler.

Claim 28 (canceled)

Claim 29 (canceled)

Claim 30 (canceled)

Claim 31 (canceled)

Claim 32 (original): The structural reinforcing member according to Claim 21 in which the expandable material is applied over part of each of the top and bottom and the sides of the reinforcing member.

Claim 33 (new): The structural reinforcing member according to Claim 21 wherein an external surface of the reinforcing member has opposite edges and the ribs are located internally of the opposite edges.

Claim 34 (new): The structural reinforcing member according to Claim 21 wherein the structural reinforcing member has cross-section shape selected from an M-shape, a U-shape or a W-shape

Claim 35 (new): A structural reinforcing member for reinforcing a hollow structural member comprising:

a plastic reinforcing member having an external surface;

a series of pairs of opposing ribs spaced apart along a length of the structural reinforcing member wherein each pair of ribs forms a groove therebetween and wherein each rib of the pairs of ribs extends transverse relative to the length of the reinforcing member and wherein each rib of the pairs of ribs is integrally molded of plastic with the reinforcing member;

unfoamed expansive adhesive material contained within the groove between the ribs of each pair of opposing ribs;

wherein the unfoamed expansive adhesive material can be activated to both expand and to act as an adhesive when heated;

wherein said unfoamed expansive adhesive material is dry and not tacky to the touch prior to activation of said material;

wherein the unfoamed expansive adhesive material is flush with a distal end of each rib for each pair of opposing ribs prior to activation;

wherein said structural reinforcing member further comprises at least one lug attached to said structural reinforcing member and locating said member within said hollow structural member when said structural reinforcing member is placed within said hollow structural member and each pair of opposing ribs approaches an internal surface of the hollow structural member prior to activation of said material;

wherein the structural reinforcing member includes a labyrinth of internal reinforcing ribs; and

wherein each pair of opposing ribs is bonded to said internal surface of said hollow structural member after activation of said material.

REMARKS

In the Office Action mailed June 24, 2003, the Examiner rejected claims 1-32. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 1, 3, 4 and 27, canceled claims 28-31 and have added claims 33-35. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Claim Rejections – 35 USC 112

The Office Action rejected claims 1-20 under 35 USC 112.

More particularly, the Office Action rejected claim 1 suggesting that, “the recitation ‘one extension adapted for opposing and which approaching’ is vague, indefinite and confusing.” Applicants have amended claim 1 to replace the rejected language and Applicants believe that the claim is definite.

The Office Action rejected claim 1 and commanded the deletion of “the second ‘one’” in line 8. Such change has been made.

The Office Action rejected claim 1, lines 8-9 and suggested that, “the recitation ‘against at least one of the extensions such that extensions locally guide the expansion of the expandable material’ appears to be vague, indefinite and confusing as to the direction the expandable material is being guided to.” In response, Applicants have amended the rejected recitation of the claim and believe that claim 1 is definite.

The Office Action rejected claim 3, line 3 and suggested the term “extremity” should be replaced with the phrase “outer surfaces”. Such replacement has been made.

The Office Action suggested rewriting claim 4 in Markush format. Thus, claim 4 has been so rewritten.

II. Rejections under 35 USC 102 and 103

The Office Action rejected claims 1 and 2 under 35 USC 102(e) as being anticipated by U.S. Patent 6,253,524 to Hopton et al (hereinafter referred to as Hopton

et al.). The Office Action rejected claims 3-20 under 35 USC 102(e) as anticipated by or, in the alternative, under 35 USC 103 as obvious over Hopton et al. The Office Action then rejected claims 21-32 suggesting only that claim 21-32, "essentially contain the same claimed elements of claims 1-20".

With regard to the rejection of claims 1 and 2 and the rejection of claims 3-20, Applicants traverse these rejections. However, Applicants have added additional language to claim 1 to assist in clarifying the novelty of claims 1 - 20.

With regard to the rejection of claims 21-32, Applicants traverse this rejection and suggest that the Office Action does not set forth a prima facie case of obviousness. In particular, the Office Action appears to have ignored language of claim 21 thereby contravening the requirements for forming a prima facie case of obviousness. As such, Applicants traverse the rejection of claim 21 and its dependents, claims 22-32.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). However, it appears that the Office Action rejected claims 21 and its dependents 22-32 without considering entire phrases of claim 21. In particular, the Office Action does not appear to consider language of claim 21 reciting that the pair of ribs are "extending the length of said structural reinforcing member." Moreover, the Office Action appears to ignore the entire phrase that reads, "wherein said unfoamed expansive adhesive material is dry and not tacky to the touch prior to activation of said material."

The language discussed above is provided in the claim 21, but is apparently ignored by the Office Action. Thus, the Office Action fails to assert a prima facie case of obviousness and Applicants respectfully request that the rejections of claims 21-32 be withdrawn and that those claims be allowed.

Furthermore, Applicants point out that it would likely be improper to present a final rejection of claims 21-32 on a grounds alternative to that already presented since applicants have not amended claim 21 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor base on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor base on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

III. New Claims

Applicants have added new claim 33-35 to address various aspects of the invention of the present application.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

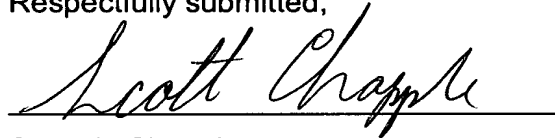
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Dated: 9-9, 2003

Respectfully submitted,

A handwritten signature in cursive script, reading "Scott A. Chapple", is written over a horizontal line.

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